

21C-0077

**REMARKS**

Claims 1-14 are pending in the present Application. Claims 1, 4, 7, and 9-11 have been amended leaving claims 1-14 for consideration upon entry of the present Amendment. The Specification has been amended to correct certain typographical errors. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Amendments

Claims 1, 7, 10, and 11 were amended to contain about 30 to 50% by weight of a hard segment and about 50 to 70% by weight of a soft segment. Support can be found in the Specification as filed on page 5, line 25 to page 6, line 7, and Examples 1-3.

Claim Objections

Claim 8 was objected to for spelling errors to the word "morpholine" and "dilaurate". Applicants respectfully assume the Examiner meant claim 9. The misspellings found in claim 9 are corrected herein by amendment.

Claim 4 and 5 were objected to as depending upon a rejected claim. In an Examiner's telephone call of September 3, 2004 the Examiner indicated that claims 4 and 5 were allowable. Accordingly, claim 4 has been rewritten in independent form to contain all of the elements of original claim 1, thereby removing the source of objection.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 11-14 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in relevant art how to make and/or use the invention. Applicants respectfully disagree.

The Examiner stated the following in the Office Action of August 25, 2004:

21C-0077

The method of these claims is directed to copolymerizing the hard and soft segments and then dissolving. In the disclosure and the examples, the hard and soft NCO terminated components are dissolved without copolymerization. The examples show that the NCO groups remain unreacted...Further, after copolymerization, the resin would probably be insoluble. The claims should be directed to the invention of the disclosure.

Claim 11 is directed to a method of preparing a paint composition including a one-part polyurethane resin composition comprising, preparing a hard segment and a soft segment; copolymerizing the hard segment and the soft segment to prepare the one-part polyurethane resin composition; dissolving the one-part polyurethane resin composition in a solvent; and adding a catalyst to the dissolved one-part polyurethane resin composition to give the paint composition.

The Applicants respectfully assert that the Specification as filed does provide teaching for both i) dissolving the hard segment and soft segment prior to copolymerizing (e.g., Example 3) and ii) for adding a catalyst to a dissolved one part polyurethane composition (see page 12, line 15 to page 13, line 12).

In Example 3, the catalyst is used to copolymerize the reaction between the hard and soft segments. The catalyst in claim 11, however, is used to reduce the hardening time of the one part polyurethane composition. Support for this idea can be found on page 12, line 10 to page 13, line 12; and page 3, line 20 to page 4, line 4 of the Specification as filed.

Finally, attached is a product sheet for Desmodur E-3265, an aliphatic polyisocyanate prepolymer containing copolymerized hard and soft segments. As indicated on the first page, this prepolymer is soluble in "most esters, ether esters, ketones, toluene, and xylene." (See, Desmodur E-3265 product sheet) As the Applicants have demonstrated support in the specification for the particular process of claim 11 and for the solubility of a polyurethane resin, reconsideration and removal of the § 112 rejection is respectfully requested.

21C-0077

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-3 and 6-10 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 6,191,212 to Kube ("Kube").

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Independent claims 1, 7, and 10 have been amended to contain about 30 to 50% by weight of a hard segment and about 50 to 70% by weight of a soft segment. Kube does not teach a polyurethane resin composition having the particular amounts of hard and soft segments as required by these claims. Rather, Kube generally discloses moisture-curing hotmelt adhesives containing polyurethane prepolymers. The hot-melt adhesive can contain 80 to 99.8% by weight of polyurethane prepolymers and 20 to 0.2% by weight of isocyanurates that are trimers of diisocyanates. Therefore, Kube fails to teach each and every element of the claims as the amounts of hard segments and soft segments are not taught. Claims 2-3, 6, and 8-9 all ultimately depend from independent claims 1, 7, and 10 and also contain the claim element of the particular amounts of hard and soft segments. Accordingly, reconsideration and removal of the rejections is respectfully requested.

It is further noted that independent claims 1, 7, and 10 have been amended to a one-part polyurethane resin composition for paint. As mentioned previously, Kube is generally directed to hot-melt adhesives containing polyurethane prepolymers. Kube does not teach or suggest a one part polyurethane resin composition that can be used to prepare a paint. Accordingly, the Applicants respectfully request removal of the outstanding rejections and allowance of the claims.


It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

21C-0077

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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